



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S) : Bowen, et al.
SERIAL NO. : 10/502,080
FILED : 10/8/2004
FOR : Solenopsin A, B and Analogs as Novel Angiogenesis Inhibitors
GROUP ART UNIT : 4133
Examiner : J.S. Kudla

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**Election of Invention/Species in Response
to Restriction Requirement**

In response to the Examiner's correspondence dated January 31, 2008, pursuant to the Examiner's further requirement to restrict the elected invention to a single cancer species for examination in the above-referenced patent application, Applicant provisionally elects with traverse to prosecute the invention of Group I, drawn to a composition of a pharmaceutical composition and a method of treating a tumor or cancer, in particular, a species of a cutaneous malignancy (non-melanoma skin cancer) in a patient comprising administering a pharmaceutical composition. In addition, Applicant provisional elects with traverse to prosecute Solenopsin A, trans-2-methyl 6-n-undecyl piperidine in treating cutaneous cancers (non-melanoma cancer of the skin). It is respectfully requested that the Examiner consider examining Solenopsin B, a 2,6-trans-dialkyl piperidine, as well as Solenopsin A. Claims 1, 2, 5, 6, 7, 8, 15, 38 and 39 (as amended) are readable on the elected species.

Applicants submit that the group of compounds which are reflected in Applicants' modified species of two compounds is sufficiently narrow to allow the Examiner to examine the instant application.

Notwithstanding Applicants' election, Applicant respectfully traverses the Examiner's

Restriction Requirement
S.N. 10/502,080
B40-002.second restriction 3-08

requirement for restriction. Applicants respectfully submit that prosecution of the originally filed claims should not be restricted to the elected invention.

As Applicant has previously argued, according to M.P.E.P. §803, restriction by the Examiner of patentably distinct inventions is proper if the claimed inventions are independent and a serious burden would be placed on the Examiner if restriction was not required. Applicant respectfully submits that the presentation of the originally filed claims would not place such a serious burden on the Examiner as to require restriction. All of the originally filed claims are related, though patentably distinct chemical compositions having similar pharmacological properties.

Although the claimed compositions are generally patentably distinct from each other, Applicant respectfully submits that any search the Examiner would need to conduct in examining the instant application would not be unduly burdensome. Moreover, the examination of all of the originally filed claims in the instant application would not place such a serious burden on the Examiner as to require restriction.

Applicant understands the general policy considerations for the Patent Office's requirement for restriction in certain instances. In this instance, however, those considerations do not weigh in favor of restricting the inventions here. In determining the appropriateness of restriction, one must also consider the countervailing consideration that, in each instance, Applicant wishes the Patent Office to examine his or her application with a certain degree of "administrative efficiency" and wishes to have patent claims issue which reflect the breadth of his or her invention.

Applicant respectfully submits that the originally filed claims are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in M.P.E.P. §803. Consequently, Applicant respectfully requests that the Examiner

withdraw the restriction requirement or at least examine the broader alternative species selected.

No fee is believed due for the presentation of this amendment. If the Examiner determines that any fee is due, please charge any fee due to Deposit Account No. 04-0838. A petition for an extension of time of one month is enclosed as is a check in the amount of \$60.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 25, 2008.


Henry D. Coleman (Reg. No. 32,559)